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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,075	02/19/2004	Charles R. Weirauch	200314899-1	7028

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FORT COLLINS, CO 80527-2400

EXAMINER

BIBBINS, LATANYA

ART UNIT	PAPER NUMBER
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2627

NOTIFICATION DATE	DELIVERY MODE
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11/14/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/784,075	Applicant(s) WEIRAUCH ET AL.	
	Examiner LaTanya Bibbins	Art Unit 2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6 and 9-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6 and 9-16 is/are rejected.
- 7) ☒ Claim(s) 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 5, 2008 has been entered.

2. In the remarks filed on September 5, 2008, Applicant amended claims 1, 5, 6, 15, and 16, cancelled claims 3, 7, and 8, and submitted arguments for allowability of pending claims 1, 2, 4-6, and 9-16.

Response to Arguments

3. Applicant's arguments filed September 5, 2008 have been fully considered but they are not persuasive.

Applicant argues that the Murakami reference does not teach or suggest that the second surface which contains auxiliary information is an "exterior" surface. Applicant points to the burst cutting area (BCA) of Murakami, specifically the discussion in column 14 line 44-51 and column 7 lines 16-20 which indicate that the BCA is on an interior surface. Applicant further asserts that Murakami has no provision for using an external surface for the auxiliary information.

Murakami, however, suggests that the second surface is an exterior or external surface (see column 5 line 59 through column 6 line 3 and the discussion regarding "the

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stripe back side identifier" which "shows the existence of additional information recorded at the back side of the optical disk"). However, in the interest of clarity, newly identified prior art reference Yagi (US Patent Number 5, 699,342) more clearly discloses a second, exterior or external, optically readable surface (Figure 22A, element 69 and the discussion in column 18 lines 44 and 45). See the 35 U.S.C. 103(a) rejection below.

As such, Applicant's arguments with respect to claims 1, 2, 4-6, and 9-16, while not persuasive, have been considered but are moot in view of the new grounds of rejection.

Claim Objections

4. Claim 15 is objected to because of the following informalities: lines 7 and 8 of claim 15 recite "an the external surface." Appropriate correction is required. In the interest of compact prosecution, Examiner will interpret "an the external surface" as "an external surface."

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 2, 4-6, 9, 10, and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murakami et al. (US Patent Number 6,973,015 B1) in view of Yagi et al. (US Patent Number 5,699,342).

Regarding claim 1, Murakami discloses a method, comprising: refusing, by a drive, to optically read information encoded on a first optically readable surface of an optical medium (see the TOC area in Figure 1A element 103) when required auxiliary information cannot be optically read from a second, exterior, optically readable surface (see the additional information area in Figure 1A element 101 and the flowchart of a reproduction procedure in Figure 10A, specifically element 301i where an error is created when information can not be reproduced from the additional information area, further see column 5 line 59 through column 6 line 3 where Murakami discusses "the stripe back side identifier" which "shows the existence of additional information recorded at the back side of the optical disk"), the first optically readable surface being underneath and optically read through the second optically readable surface (column 5 line 59 – column 6 line 3 and the discussion regarding double sided type disks such as a DVD-ROM disk comprised of two layers of recording layers with a BCA in either the first or second recording layer in column 14 lines 42-59).

While Murakami suggests that the second surface is an exterior surface (see column 5 line 59 through column 6 line 3 and the discussion regarding "the stripe back side identifier" which "shows the existence of additional information recorded at the back side of the optical disk"), in the interest of clarity, Yagi discloses a second, exterior,

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optically readable surface (Figure 22A, element 69 and the discussion in column 18 lines 44 and 45).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the exterior optical readable surface of Yagi into the teachings of Murakami. One of ordinary skill in the art at the time the invention was made would have been motivated to combine the teachings in order to get information regarding the optical medium (for example disk type) prior to reproduction (as suggested by Yagi in column 18 lines 54-64).

Regarding claim 2, Murakami further discloses optically reading, from the first optically readable surface, at least part of the information that indicates that the auxiliary information is required on the second optically readable surface (see column 5 lines 29-40).

Regarding claim 4, Murakami further discloses wherein the first optically readable surface is an internal data surface of the optical disk (see Figure 1A with a first surface, the TOC area 103, and a second surface, the additional information area 101, and column 5 lines 9-12 where the additional information area may be located at the outer peripheral portion of the disc).

Regarding claim 5, Murakami discloses an optical medium (Figure 1A element 100), comprising: a first surface (see the TOC area in Figure 1A element 103), the first surface comprising encoded information that comprises an indication that information encoded on a second surface is required to permit access to content on the first surface (see column 5 lines 29-40); the information encoded on the second surface

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corresponding to the indication on the first surface (see the additional information area in Figure 1A element 101) and an upper optically readable surface of the first and second surfaces being partially reflective and permitting optical access to a lower optically readable surface of the first and second surfaces underneath the upper optically readable surface (column 5 line 59 – column 6 line 3).

While Murakami suggests that the second surface is an external surface (see column 5 line 59 through column 6 line 3 and the discussion regarding "the stripe back side identifier" which "shows the existence of additional information recorded at the back side of the optical disk"), in the interest of clarity, Yagi discloses an, external surface (Figure 22A, element 69 and the discussion in column 18 lines 44 and 45).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the external surface of Yagi into the teachings of Murakami. One of ordinary skill in the art at the time the invention was made would have been motivated to combine the teachings in order to get information regarding the optical medium (for example disk type) prior to reproduction (as suggested by Yagi in column 18 lines 54-64).

Regarding claim 6, Murakami further discloses the first surface being an internal data surface (see Figure 1A with a first surface, the TOC area 103, and a second surface, the additional information area 101, and column 5 lines 9-12 where the additional information area may be located at the outer peripheral portion of the disc).

Regarding claim 9, Murakami further discloses the information encoded on the second surface comprising a bar code (see column 5 lines 12-14).

Regarding claim 10, Murakami further discloses the information encoded on at least one of the first and second surfaces comprising data in a control block (see Figure 1B).

Regarding claim 12, Murakami further discloses the information encoded on at least one of the first and second surfaces comprising data embedded within other data (see Figure 1B and Figures 2A and 2B where both the TOC and the additional information areas contain embedded data).

Regarding claim 13, Murakami further the information encoded on the second surface comprising variable information (see the description of the data contained in the additional information area in column 6 lines 9-42 and the illustration in Figures 2A and 2B).

Regarding claim 14, Murakami further discloses the information encoded on the second surface comprising a unique identifier of the optical medium (see column 5 lines 21 and 22 and further in column 9 lines 6-8).

Regarding claim 15, Murakami discloses a drive for optical media, comprising: a controller, the controller permitting external access to information encoded on an internal optically-readable surface on an optical medium, only when required encoded information can be optically read from an external second surface on the optical medium (see column 13 lines 33-39 and further in column 13 lines 48-53 and Figure 7 element 523) wherein the controller causes a lens to optically focus on the internal optically-readable surface through an external surface (column 5 line 59 – column 6 line 3).

While Murakami suggests an external surface (see column 5 line 59 through column 6 line 3 and the discussion regarding "the stripe back side identifier" which "shows the existence of additional information recorded at the back side of the optical disk"), in the interest of clarity, Yagi discloses an external surface (Figure 22A, element 69 and the discussion in column 18 lines 44 and 45).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the external surface of Yagi into the teachings of Murakami. One of ordinary skill in the art at the time the invention was made would have been motivated to combine the teachings in order to get information regarding the optical medium (for example disk type) prior to reproduction (as suggested by Yagi in column 18 lines 54-64).

Regarding claim 16, Murakami discloses a drive for optical media, comprising: means for detecting that information encoded on an external surface of an optical medium is required (see the TOC area in Figure 1A element 103); and means for refusing to permit external access to information encoded on an internal surface of the optical medium, unless the required information encoded on the external surface can be read by the drive (see the flowchart of a reproduction procedure in Figure 10A, specifically element 301i where an error is created when information can not be reproduced from the additional information area) and means for optically focusing on the internal surface through the external surface (column 5 line 59 – column 6 line 3).

While Murakami suggests an external surface (see column 5 line 59 through column 6 line 3 and the discussion regarding "the stripe back side identifier" which

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"shows the existence of additional information recorded at the back side of the optical disk"), in the interest of clarity, Yagi discloses an external surface (Figure 22A, element 69 and the discussion in column 18 lines 44 and 45).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the external surface of Yagi into the teachings of Murakami. One of ordinary skill in the art at the time the invention was made would have been motivated to combine the teachings in order to get information regarding the optical medium (for example disk type) prior to reproduction (as suggested by Yagi in column 18 lines 54-64).

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murakami et al. (US Patent Number 6,973,015 B1) in view of Yagi et al. (US Patent Number 5,699,342), as applied to claim 5 above, and further in view of Suh et al. (US PGPub Number 2004/0168074 A1).

Regarding claim 11, the combination of Murakami and Yagi disclose the optical medium including all of the limitations of claim 5 but fails to teach that the optical medium comprises the information encoded on at least one of the first and second surfaces comprising data encoded in groove wobble. Suh, however, teaches an optical medium where the information encoded on at least one of the first and second surfaces comprises data encoded in groove wobble (see paragraph [0050]-[0052] and Figures 4F and 5).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to encode the copy protection information in wobbled pits as taught by Suh onto the optical medium of Murakami and Yagi. One of ordinary skill in the art at the time the invention was made would have been motivated to combine the teachings in order to prevent the information from being easily detected by common detecting methods (see Suh paragraph [0051]).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaTanya Bibbins whose telephone number is (571)270-1125. The examiner can normally be reached on Monday through Friday 7:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wayne Young can be reached on 571 272-7582. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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/LaTanya Bibbins/
Examiner, Art Unit 2627

/Wayne Young/
Supervisory Patent Examiner, Art Unit 2627